

*Contd
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a plate having a top surface; and
at least one laser capture microdissection cap coupled to said top surface of said plate,
wherein said at least one laser capture microdissection cap includes
a transfer film carrier having a substrate surface; and
a laser capture microdissection transfer film coupled to said substrate surface of said transfer film
carrier, wherein said laser capture microdissection transfer film includes at least one integrally
formed structural feature that protrudes and provides a controllable space in between said laser
capture microdissection transfer film and a sample.

REMARKS

Favorable reconsideration of this application is requested in view of the foregoing amendments and the following remarks. Claims 1-44 are pending. Nonelected claims 45-48 are cancelled without prejudice or disclaimer.

Claims 1, 16 and 31 are rejected under 35 U.S.C. 112, second paragraph, for omitting essential elements. The preambles of claims 1, 16 and 31 are amended to merely recite "an apparatus".

Accordingly, withdrawal of this rejection is respectfully requested.

Claims 11-12, 15, 26-27, 30, 41-42 and 44 were rejected by the Examiner under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 15, 30 and 44 are rewritten in independent form.

Claims 11, 12, 26-27, and 41-42 recite flatness limitations that are clear to those of skill in the art. Claims 11, 26 and 41 require that the thickness of the laser capture microdissection transfer film vary no more than 20% from a nominal thickness. For example, given a nominal thickness of 500 microns, the thickness of the laser capture microdissection transfer film will be no

more than 600 microns and no less than 400 microns. Claims 12, 27 and 42 require that the capture surface have an elevation above a nominal plane that varies no more than 5 microns. For example, the scalar displacement from the high point on the capture surface to the low point on the capture surface cannot be more than 5 microns.

Accordingly, withdrawal of this rejection is respectfully requested.

Claims 16 and 31 are rejected under 35 U.S.C. 102(e) as being anticipated by Baer et al. (WO 98/35215). This is the WIPO publication of PCT/US98/01285 which claims priority to U.S. Serial No. 08/709,026, filed February 7, 1997, now U.S. Patent No. 5,859,699.

Claims 16 and 31 (as well as claims 38 and 44) are amended to require that the laser capture microdissection transfer film include an integrally formed structural feature that protrudes and provides a controllable spacing between the laser capture microdissection transfer film and a sample. The Baer et al. (WO 98/35215 or U.S. Patent No. 5,859,699) does not disclose or suggest such a structural feature.

Accordingly, withdrawal of this objection is respectfully requested.

Claims 1-15, 17-30 and 32-44 were rejected under 35 U.S.C. 103(a) as being unpatentable over Baer et al. (WO 98/35215). This rejection is untenable.

The invention is directed to a laser capture transfer film that includes an integrally formed structure for controlling the space between the transfer film and the sample. This limitation is not known in the art, much less disclosed or suggested by the references of record. At page 3, lines 14-18, the Examiner states that "Using the integrally formed structure for controlling the space between the transfer film and the sample is well known in the art so it would have been obvious to one having ordinary skill in the art at the time of (sic) the invention was made to modify Baer's

apparatus with the integrally formed structure to control the space and to reduce the system cost." Contrary to the Examiner's assertion, this limitation is not known in the art. The Examiner's assertion is nothing more than speculation. Applicant insists that the Examiner cite a prior art publication on the record or withdraw the assertion. In addition, the Examiner's alleged motivation is derived from the instant application. Applicant teaches lowering costs. See page 21, lines 7-9 of the instant application. It is improper for the Examiner to use teachings from Applicant's own specification as motivational rationale for combining references when those teachings are not disclosed or suggested in the prior art of record.

Accordingly, withdrawal of this rejection is respectfully requested.

Other than as explicitly set forth above, this reply does not include an acquiescence to any statements by the Examiner. In view of the above, the claims are considered allowable and favorable action is requested. In the event that there are any remaining issues, the attending to of which would expedite the allowance of this application, the Examiner is invited to contact the undersigned for prompt action at the telephone number appearing below.

In accordance with 37 CFR 1.136(a) pertaining to patent application processing fees, Applicant requests an extension of time from June 14, 2000 to July 14, 2000 in which to respond to the Office Action dated March 14, 2000.

The Commissioner is hereby authorized to charge payment of any deficiency or credit any overpayment to Deposit Account No. 23-2415.

Respectfully submitted,

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By


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